



PROTECTING YOUR INTELLECTUAL PROPERTY AT HOME AND ABROAD

*A Brief
Business Guide to
IPR Enforcement*



"As inventors, innovators and entrepreneurs, each of you deserves to have your products and ideas protected from theft. Enforcing intellectual property laws is an essential element of economic reform and long-term economic growth."

Donald L. Evans,
U.S. Secretary of Commerce

AMERICA'S INNOVATION:

American businesses lead the world in producing new ideas and innovations. Through their products, our inventors, scientists, artists and business people bring convenience, safety and a better way of life to people throughout the world. The intellectual property we produce delivers life saving medicines, builds faster computers, and creates cutting-edge entertainment. The intellectual property developed in the United States remains one of our most competitive and job-creating exports.

The U.S. Government is dedicated to protecting America's innovation at home and abroad. The following is a list of U.S. Government resources that may assist companies in protecting their intellectual property.

PROTECTION AT HOME:

U.S. Patent and Trademark Office: The first step in ensuring protection of intellectual property is registering for protection at the U.S. Department of Commerce's Patent and Trademark Office (USPTO). A U.S. patent is the grant of a property right to the inventor(s) of an invention, issued by the USPTO. The right conferred by the patent grant is "the right to exclude others from making, using, offering for sale, or selling" the invention in the United States or "importing" the invention into the United States. To get a U.S. patent, an application must be filed in the USPTO.

A trademark is a word, phrase, symbol or design, or a combination of words, phrases, symbols or designs, that identifies and distinguishes the source of the goods of one party from those of others. A service mark is similar to a trademark except that it identifies and distinguishes the source of a service rather than a good. The USPTO reviews trademark applications and determines whether an application meets the requirements for federal registration. The USPTO does not decide whether you have the right to *use* a mark (which differs from the right to register). Even without a registration, you may still *use* any mark adopted to identify the source of your goods and/or services. It is up to the registrant to enforce its rights in the mark against junior users and trademark applicants.

For more information on registering for a patent or trademark in the United States contact:

Patent and Trademark Assistance Center

Phone: 1-800-786-9199 or (703) 308-4357

Web site: www.uspto.gov

To file with the USPTO electronically visit:

PATENTS: www.uspto.gov/ebsd/efs/index.html

TRADEMARKS: www.uspto.gov/teas/index.html

U.S. Copyright Office: Copyright reserves to authors the exclusive control of their "writings," such as literary, musical, pictorial and audiovisual works, including computer programs, for a fixed period of time. Although copyright protection is automatic, for information on securing a U.S. copyright registration, contact:

U.S. Copyright Office

Phone: (202) 707-5959

Web site: www.copyright.gov

U.S. Customs and Border Protection: Once a company secures a trademark registration from the U.S. Patent and Trademark office, or in the case of copyright, from the U.S. Copyright Office, the registration should be recorded with U.S. Customs and Border Protection (CBP). Recordation of a federally registered trademark or copyright significantly aids in the border enforcement of such rights. The recordation fee is \$190. Applications to record a trademark, copyright, or trade name must be in writing and should be addressed to:

U.S. Customs and Border Protection

Office of Regulations and Rulings
Intellectual Property Rights Branch

1300 Pennsylvania Avenue, NW
Mint Annex
Washington, D.C. 20229

Phone: (202) 572-8710

Fax: (202) 344-1873

An applicant wishing to record an intellectual property right with CBP may refer to the CBP website for further information and for forms that may be used to complete a recordation: www.cbp.gov/. The Intellectual Property Rights Branch email address is hqiprbranch@dhs.gov.

U.S. Department of Justice: Intellectual property crime, such as copyright piracy, trademark counterfeiting, or internet fraud, like any other crime, should be reported to appropriate law enforcement investigative authorities at the local, state, federal, or international levels, depending on the scope of the crime. Citizens or companies aware of federal crimes should report them to local offices of federal law enforcement. Federal law enforcement agencies have offices conveniently located in every state. In general, federal crime may be reported to the local office of an appropriate law enforcement agency by a telephone call and by requesting the "Duty Complaint Agent." Contact information regarding these local offices may be found at:

U.S. Department of Justice

Phone: (202) 324-3000

Web site: www.cybercrime.gov/reporting.htm

National Intellectual Property Rights Coordination Center:

If a company learns of infringement occurring in the United States, it should contact the National Intellectual Property Rights Coordination Center (IPR Center). The IPR Center is a multi-agency center responsible for coordinating a unified U.S. Government response regarding IPR enforcement issues. Investigative personnel provide core staffing from Immigration and Customs Enforcement (ICE) and the Federal Bureau of Investigation (FBI). If a company has specific information concerning IPR crimes, it can complete a complaint form at www.ice.gov/graphics/cornerstone/ipr/IPRForm.htm. Companies may also contact the Center by mail or telephone:

U.S. Immigration and Customs Enforcement

National Intellectual Property Rights Center

1300 Pennsylvania Avenue, NW, Rm. 3.5A
Washington, DC 20229

Phone: (202) 344-2410

Fax: (202) 344 1920

PROTECTION ABROAD:

Our international trade agreements and related intellectual property treaties require member countries to provide for means by which rights holders can enforce their intellectual property rights. It is important to note that intellectual property rights are generally territorial. That is, a U.S. patent or trademark provides protection only in the United States; a Japanese patent provides protection only in Japan, etc. This means that, in most cases, the first step in protecting intellectual property beyond U.S. borders is for companies to register their trademark or patent with the appropriate authorities in each country or through international treaties that are administered by the World Intellectual Property Organization (WIPO).

For more information on how to apply for patents or trademarks in a foreign country, contact the intellectual property office in that country directly. A list of contact information for most intellectual property offices worldwide can be found at wipo.int/news/en/links/addresses/ip/index.htm. Once a company has registered for protection, it can use that country's local laws to enforce its rights. Although most countries do not require registration to enjoy copyright protection, registration can bring certain benefits, such as proof of ownership. Because of the legal complexities involved with IP protection, it is suggested that the advice of an IP lawyer be sought where needed.

U.S. Patent and Trademark Office: The Patent Cooperation Treaty (PCT) streamlines the process for U.S. inventors and businesses wishing to obtain patent protection in other countries. By filing one international patent application with the USPTO, U.S. applicants can concurrently seek protection in up to 115 countries. For an invention made in the United States, U.S. law prohibits filing abroad without a foreign filing license from the USPTO, unless six months have elapsed since filing a U.S. application. For filing an international patent application under the PCT, visit the USPTO website:

www.uspto.gov/go/pct/. Additional information on the PCT is also available on the WIPO website: www.wipo.org/pct/en/index.html.

The Madrid Protocol streamlines the process for U.S. trademark owners wishing to obtain trademark protection in other countries. By filing one international trademark application with the USPTO, U.S. applicants can concurrently seek protection in up to 66 countries. Changes to a registration, e.g., transfers, name or address changes and renewals can be handled through a single procedural step. For filing an international trademark application under the Madrid Protocol, visit the USPTO website: <http://www.uspto.gov/web/trademarks/madrid/madridindex.htm>. Additional information on the Madrid Protocol is also available on the WIPO website: <http://www.wipo.int/madrid/en/>

Market Access and Compliance: The Department of Commerce's Market Access and Compliance (MAC) unit is ready to help U.S. business overcome trade barriers and ensure that foreign countries comply with their trade agreement and treaty commitments to the United States. MAC's Trade Compliance Center (TCC) and country experts stand ready to work with U.S. companies to enforce their intellectual property rights (IPR) in foreign markets. MAC experts can suggest strategies to evaluate IPR problems encountered abroad and will work with our Embassies around the world to pursue a course of action for resolution of the problems. MAC has established a special telephone and web address designed specifically to deal with companies' international intellectual property concerns. Companies can contact MAC about IPR problems abroad at:

U.S. Department of Commerce

Trade Compliance Center

14th Street and Constitution Avenue, NW
Washington, D.C. 20230

Phone: 1-800-USA-TRADE (option four)

(202) 482-1191

Fax: (202) 482-6097

E-Mail: ipr.hotline@mail.doc.gov

Web: export.gov/tcc